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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,552	01/21/2004	Jeff Kirsner	HALB:020D1	2843

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Karen B. Tripp
Attorney at Law
P.O. Box 1301
Houston, TX 77251-1301

EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/761,552

Applicant(s)

KIRSNER ET AL.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-25 and 27-44 is/are pending in the application.
- 4a) Of the above claim(s) 23,25,27-32 and 40-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24 and 33-39 is/are rejected.
- 7) ☒ Claim(s) 35 and 36 is/are objected to.
- 8) ☒ Claim(s) 23-25 and 27-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/03/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 23-25 and 27-44 are pending as amended on 4 December 2006, claims 1-22 and 26 being cancelled. Claims 23, 25, 27-32 and 40-44 are withdrawn from consideration.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

Response to Amendment

3. Applicant's amendment filed 4 December 2006 has been entered and fully considered.

Election/Restrictions

4. This application contains claims 23, 25, 27-32 and 40-44 drawn to an invention nonelected in the response filed 6 April 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Information Disclosure Statement

5. The information disclosure statement submitted on 3 July 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Claim Objections

6. Claims 35 and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

Claim 35 limits the paraffin hydrocarbons to from about 1 to about 99 weight percent of the blend; however, amended claim 24—from which claim 35 depends—limits the paraffin hydrocarbons to less than about 90 weight percent of the blend.

Claim 36 limits the isomerized olefins to from about 1 to about 99 weight percent of the drilling fluid; however, amended claim 24—from which claim 36 depends—limits the paraffin hydrocarbons to less than about 90 weight percent of the blend.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 24 and 33-39 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 35 each recite the limitation "the blend". There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, claim 24 was construed to recite, "...wherein the invert emulsion has a base or continuous phase comprising a blend of..."

Double Patenting

9. Claims 24 and 33-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 195, 240 and 285 of copending Application 10/933,560.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application fully embrace the claims of the instant application in claiming drilling methods using a composition comprising isomerized olefins, paraffin and esters and the specification of the copending application shows the esters to comprise at least about 10 weight percent to about 99 weight percent of the blend, the olefins to comprise about 1 weight percent to about 99 weight percent of the blend (Copending Specification ¶¶0013) and the paraffins to be comprised of about 10 to about 30 carbon atoms and comprise about 1 to about 99 weight percent of the blend (Copending Specification ¶¶0054). See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 24 and 33-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/633,703, filed since the mailing date of the previous Office action.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the copending application fully embrace the claims of the instant application in claiming drilling methods using a composition comprising isomerized olefins, paraffin and esters and the specification of the copending application shows the esters to comprise at least about 10 weight percent to about 99 weight percent of the blend (Copending Specification ¶0046), the olefins to comprise about 1 weight percent to about 99 weight percent of the blend (Copending Specification ¶0047) and the paraffins to be comprised of about 10 to about 30 carbon atoms and comprise about 1 to about 99 weight percent of the blend (Copending Specification ¶0050). See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 24 and 33-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/633,704, filed since the mailing date of the previous Office action.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the copending application fully embrace the claims of the instant application in claiming drilling methods using a composition comprising isomerized olefins, paraffin and esters and the specification of the copending application shows the esters to comprise at least about 10 weight percent to

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about 99 weight percent of the blend (Coping Specification ¶0046), the olefins to comprise about 1 weight percent to about 99 weight percent of the blend (Coping Specification ¶0047) and the paraffins to be comprised of about 10 to about 30 carbon atoms and comprise about 1 to about 99 weight percent of the blend (Coping Specification ¶0050). See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 24 and 33-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/634,008, filed since the mailing date of the previous Office action.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the copending application fully embrace the claims of the instant application in claiming drilling methods using a composition comprising isomerized olefins, paraffin and esters and the specification of the copending application shows the esters to comprise at least about 10 weight percent to about 99 weight percent of the blend, the olefins to comprise about 1 weight percent to about 99 weight percent of the blend (Coping Specification ¶0012) and the paraffins to be comprised of about 10 to about 30 carbon atoms and comprise about 1 to about 99 weight percent of the blend (Coping Specification ¶0047). See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

13. Claims 24, 26 and 33-39 stand rejected under 35 USC 102(b) as being anticipated by US Patent 5,691,281 (Ashjian hereinafter).

Ashjian teaches a method of drilling a wellbore comprising circulating a drilling mud comprising an invert emulsion (Column 1 Lines 5-65) comprising a base composed of a blend of 5 to 80 weight percent (Column 6 Lines 23-27) of a long chain isomerized olefin of at least 18 carbon atoms (Column 3 Lines 26-41) and 50 to 90 weight percent of n-paraffins, iso-paraffins and cycloparaffins of 10 to 18 carbon atoms (Column 3 Lines 51-59 and Column 6 Line 38 – Column 7 Line 6) which may further comprise esters (Column 6 Lines 28-37) which, by difference, may comprise up to 45 weight percent of the blend.

Response to Arguments

14. Applicant has traversed the double patenting and anticipation rejections from the previous Office action, but makes no arguments in support of the assertion of traversal the response filed 4 December 2006.

Conclusion

15. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

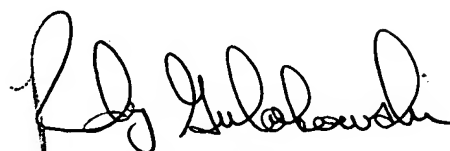
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
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RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700